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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/552,520	10/07/2005	Vincent Granier	1022702-000290	2571
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EXAMINER NILAND, PATRICK DENNIS				
ART UNIT		PAPER NUMBER		
1796				
NOTIFICATION DATE		DELIVERY MODE		
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ADIPFDD@bipc.com

Office Action Summary

Application No.

10/552,520

Applicant(s)

GRANIER ET AL.

Examiner

Patrick D. Niland

Art Unit

1796

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SG/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

1. The amendment of 2/23/09 has been entered. Claims 10-21 are pending.
2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 10-17 and 19-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A. Claims 10-17 and 19-20 provide for the use of the instantly claimed composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 10-17 and 19-20 are rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966). The steps denoted by “for” denote a future intended use and these steps are not presently required of the instant method claims.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 10-21 are rejected under 35 U.S.C. 102(b) as being anticipated by WO

97/31960 Nabavi et al. as translated by US Pat. Application Pub. No. US 2003/0158328 Nabavi et al..

Nabavi discloses compositions, which adhere to substrates and are therefore “adhesive”, made by adding the instantly claimed component b to polyisocyanates falling within the scope of those of the instant claims at the abstract; sections [0010], [0022], [0026], [0029]-[0059], particularly [0050]-[0059] which encompasses the instantly claimed component b, [0068] which falls within the scope of the instant claim 12, [0108]-[0127], particularly [0109]-[0111], which falls within the scope of the instant claims 11, 14, 15, and 17; and the remainder of the document, particularly the examples of sections [0167]-[0228]. It would appear that the polyisocyanates of the examples have the limitations of the instant claims 14-17 inherently. The newly presented claim limitations of claims 19-21 are encompassed by these sections also. The applicant's arguments regarding Nabavi's silence on the application of their compositions to bond wood or elastomer, these limitations are not required of the examined claims which are methods of making the composition and the composition. Regarding the prior art not disclosing “the fact that the composition must present the following features to be used as a bonding composition...”, the instant claims are directed to compositions and the methods of making them. The prior art encompasses the claimed NCO content and viscosities as addressed above. The intended use does not distinguish over the prior art methods and compositions disclosed because the prior art uses the instantly claimed method steps and ingredients and amounts thereof. It is also not seen that the compositions of the prior art cannot bond wood or elastomer.

The processes and compositions of the prior art therefore fall within the scope of the instantly claimed compositions and processes of making since they otherwise are composed of the instantly claimed steps and ingredients. "Adhesive" references a future intended use which does not distinguish the instant claims over the methods and compositions of the cited prior art for the reasons given above. As stated above and as is readily clear, paints and varnishes adhere to substrates and are therefore "adhesive". The applicant's arguments in this regard are not persuasive. Furthermore, the composition of the cited prior art and method of making it are not distinguished from the instant claims by the instantly claimed recitations of "adhesive" or similar language because the compositions and methods of the cited prior art have the instantly claimed ingredients and employ the instantly claimed method steps. The resulting product will therefore necessarily and inherently be able to adhere some substrate to another, were "adhesive" defined to require this in the instant claims. The examiner maintains that this is not the case in any event and the adhesion of the paints and varnishes meets the instantly claimed recitation of "adhesive".

The applicant's arguments have been fully considered but are not persuasive for the above reasons and because of the teachings of the cited prior art. The above arguments address directly the applicant's belief that the difference between paint and/or varnish and adhesive is not insignificant. This position is maintained. Take the composition of the reference, apply it to a substrate and then apply another substrate over it and see if they do not adhere. Furthermore, put a paintbrush containing the composition of the prior art on a piece of paper and see if they do not adhere. This is required by the adhesion required of paint and varnish necessarily. There are not limitations of the instant claims and cited prior art such that adhesive distinguishes over the compositions and methods of the cited prior art. No probative evidence commensurate in scope

with the cited prior art and the instant claims is seen that contradicts this fact. The arguments regarding intended use relating to claim 18 are not persuasive because claim 18 is directed to a composition, not the use thereof. The prior art composition contains the instantly claimed ingredients and is clearly adhesive as stated above. The arguments regarding the method of the instant claim 10 does not require an adhesion step. It merely requires combining ingredients or some "use". It is noted that the "use" of the instant claim 10 is undefined, as stated above. These arguments are not commensurate in scope with the instant claims and the cited prior art. They are not persuasive for these reasons therefore. The applicant argues regarding the supplied dictionary definitions of "coatings" which are argued to be completely different from adhesives. This is not true. Both are coated onto a substrate, and are therefore "coatings", and both adhere thereto. Adhesive may be said to be required to adhere to another substrate, but this step per se is not required of the instant method and composition claims, which recite no adhering step. The examiner notes that the adhesives and coatings of the instant claims and the cited prior art each contain the same ingredients and notes "ADHERENT FILM" of the supplied definition of "coating", which clearly indicates that "adhesives" are encompassed because adhesives are "adherent films". The instant claims do not exclude the ability to be protective and decorative. The function and adherent film clearly require the adhesiveness of the instantly claimed recitation of "adhesive". Thus, the future intended use "adhesive" does not distinguish the instantly claimed methods and compositions from those of the cited prior art. The definition of "adhesive" argued by the applicant recites "Adhesive is the general term and includes among others" and first states "substance capable of holding materials together by surface attachment", which the compositions of the cited prior art are clearly capable of doing by the requirement that

they adhere to a single substrate requiring that they also adhere to another substrate of the same material necessarily and inherently. See the above examples provided by the examiner, e.g. the paint brush and adhering two substrates with the prior art compositions. No probative evidence is seen to the contrary. The argued dictionary definitions of “adhesive” and “coating” are taken alone and combined with the above examiner arguments as supporting this rejection. The preamble arguments have clearly not been ignored as can be seen in the above discussion. They do not distinguish the instant methods and compositions from the cited prior art as stated above though. The caselaw argued does not address the instant fact situation, particularly in regard to the examiner’s arguments regarding the equivalence/overlap of paint and/or varnish and adhesive, particularly as it is supported by the definitions of “coating” and “adhesive” argued by the applicants.

The applicant’s arguments have been fully considered but are not persuasive for the reasons stated above and the teachings of the cited prior art. This rejection is therefore maintained.

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick D. Niland whose telephone number is 571-272-1121. The examiner can normally be reached on Monday to Friday from 10 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on 571-272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Patrick D Niland/
Primary Examiner
Art Unit 1796